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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,068	10/05/2000	Takashi Shimada	1614-1084	9496

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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT PAPER NUMBER

3623

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/679,068

Applicant(s)

SHIMADA ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004 and 05 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 18-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-13 and 15-17 is/are rejected.
- 7) ☒ Claim(s) 7 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 13, 2004, as indicated in the RCE request filed on May 5, 2004, has been entered.

Claims 1, 6-8, 13-17 have been amended.

Claims 18-24 have been withdrawn.

Claims 1-17 are presented for examination.

### ***Response to Arguments***

2. Applicant's arguments filed with the after-final amendment (submitted April 13, 2004) have been fully considered but they are not persuasive.

Applicant argues that, unlike Filepp, "the business support system of the present invention maintains the latest information (i.e., a user's personal information) that is supplied from one of the external processing system" (page 14 of Applicant's response). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the business support system of the present invention maintains the latest information (i.e., a user's personal information) that is supplied from one of the external processing

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system") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, Filepp's invention allows networked devices to communicate via a gateway. As explained in the art rejection, the Microsoft Press® Computer Dictionary (3<sup>rd</sup> ed) defines a "gateway" as follows: "A device that connects networks using different communications protocols so that information can be passed from one to the other. A gateway both transfers information and converts it to a form compatible with the protocols used by the receiving network." In order for a network to transmit communications among devices utilizing various protocols (as is indicated by use of a gateway, which is disclosed in Filepp), the network must know which protocol each respective device is using.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 8-13, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Filepp et al. (U.S. Patent No. 5,758,072).

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Filepp discloses a business support system connectable to a plurality of external processing systems that are external to the business support system and that have different protocols, the business support system comprising:

[Claim 1] a plurality of service request production means corresponding to the plurality of external processing systems, respectively, each of the service request production means producing service information request data, in a predetermined form for a corresponding one of the plurality of external processing systems, in response to a request of a user from a terminal apparatus used by the user (Fig. 2; col. 5, lines 1-6; col. 7, lines 8-18; col. 9, lines 5-10; col. 34, line 65 through col. 35, line 6; col. 35, lines 22-25; col. 71, lines 36-44 -- The Microsoft Press® Computer Dictionary (3<sup>rd</sup> ed) defines a "gateway" as follows: "A device that connects networks using different communications protocols so that information can be passed from one to the other. A gateway both transfers information and converts it to a form compatible with the protocols used by the receiving network.");

a plurality of data form conversion means corresponding to the plurality of external processing systems, respectively, each of the data form conversion means converting the form of the service information request data produced by a corresponding one of the service request production means into a form that can be processed by a corresponding one of the external processing systems and also for converting service information provided from the corresponding one of the external processing systems in response to the service information request data into the predetermined form (Fig. 2; col. 5, lines 1-6; col. 7, lines 8-18; col. 9, lines 5-10; col. 34,

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line 65 through col. 35, line 6; col. 35, lines 22-25; col. 71, lines 36-44 -- The Microsoft Press® Computer Dictionary (3<sup>rd</sup> ed) defines a "gateway" as follows: "A device that connects networks using different communications protocols so that information can be passed from one to the other. A gateway both transfers information and converts it to a form compatible with the protocols used by the receiving network."); and

service information providing means for providing the service information converted into the predetermined form by one of the data form conversion means to the terminal apparatus originating the request for the service information (Fig. 2; col. 5, lines 1-6; col. 7, lines 8-18; col. 9, lines 5-10; col. 34, line 65 through col. 35, line 6; col. 35, lines 22-25; col. 71, lines 36-44 -- The Microsoft Press® Computer Dictionary (3<sup>rd</sup> ed) defines a "gateway" as follows: "A device that connects networks using different communications protocols so that information can be passed from one to the other. A gateway both transfers information and converts it to a form compatible with the protocols used by the receiving network.");

[Claim 4] adjusting means that ensures that no one providing means for providing service information determined by the service channel determining means is overloaded (col. 9, line 56 through col. 10, line 24);

[Claim 6] data management means for managing the service information converted into the predetermined form by the one of the data form conversion means (col. 80, line 21 through col. 84, line 67); and

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determining means for determining whether or not the service information is updated by accessing the corresponding external processing system (col. 80, line 21 through col. 84, line 67);

wherein the service information providing means provides the service information converted into the predetermined form by the one of the data form conversion means from the data management means to the terminal apparatus, based on a determination by the determining means (col. 80, line 21 through col. 84, line 67).

As per claims 1 and 5, Filepp discloses different communication means comprising computer terminals, cable television, broadcast media, and communication managers that can create a dial-up link on the public switched telephone network (col. 5, lines 1-6; col. 89, lines 25-36); however, Filepp does not explicitly teach the use of a telephone *per se* or a facsimile machine. Filepp does teach a gateway, which as stated above, inherently "connects networks using different communications protocols so that information can be passed from one to the other." Official Notice is taken that it was old and well-known in the art at the time of Applicant's invention to communicate information to telephones, facsimile machines, and computer terminals. The versatility of being able to communicate with multiple types of communications means allows one to communicate with a larger group of people. Since Filepp targets advertisements to users, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt Filepp's gateway to transmit information, such as advertisements, to users of telephones, facsimile machines, and

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computer terminals in order to reach a wider audience when transmitting advertisements.

As per claims 2 and 3, Filepp provides various types of service information, including ads that are customized based on a user's demographics (col. 9, lines 23-43). Filepp even utilizes "conventional marketing analysis techniques" to assist in this targeting of ads (col. 9, lines 39-43), yet Filepp fails to explicitly disclose a sales campaign monitoring means for monitoring the effectiveness of a sales campaign based on the service information provided to the customers, service information determining means for deciding which type of service information should be provided to customers depending on the effectiveness of the monitored sales campaign, and service channel determining means for determining a providing means for providing service information to the customer depending on the success rate of the monitored sales campaign. However, Official Notice is taken that it was old and well-known in the art of marketing at the time of Applicant's invention to evaluate the effectiveness of one's marketing campaign based on the service information provided to the customers and then decide which type of service information should be provided to customers depending on the effectiveness of the monitored sales campaign. A constant reevaluation of one's marketing campaign assists in ongoing improvement of the campaign especially in light of changing times and circumstances. Furthermore, Official Notice is taken that it was old and well-known in the art of marketing at the time of Applicant's invention to monitor a sales campaign in order to assess the most effective modes of communicating sales information (e.g., advertising) to potential customers. Again, a constant reevaluation of



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all aspects of one's marketing campaign assists in ongoing improvement of the campaign especially in light of changing times and circumstances. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement with Filepp's targeted advertising functionality a sales campaign monitoring means for monitoring the effectiveness of a sales campaign based on the service information provided to the customers, service information determining means for deciding which type of service information should be provided to customers depending on the effectiveness of the monitored sales campaign, and service channel determining means for determining a providing means for providing service information to the customer depending on the success rate of the monitored sales campaign in order to facilitate a constant reevaluation of all aspects of Filepp's promotional marketing campaigns, thereby assisting in ongoing improvement of the campaign especially in light of changing times and circumstances.

[Claims 8-13, 15-17]      Claims 8-13 and 15-17 recite limitations already addressed by the rejection of claims 1-8 above; therefore, the same rejection applies.

***Allowable Subject Matter***

5.      Claims 7 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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**Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:


**Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450**

or faxed to:

**(703)305-7687** [Official communications; including  
After Final communications labeled  
"Box AF"]

**(703)746-7048** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7<sup>th</sup> floor receptionist.

  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623  
June 26, 2004